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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/387,135	08/31/1999	NICHOLAS D.P. COSFORD	SIBIA1290	2223

7590 12/03/2002

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EXAMINER
CHOI, FRANK I

ART UNIT	PAPER NUMBER
1616	

DATE MAILED: 12/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/387,135	Applicant(s) COSFORD ET AL.	
	Examiner Frank I Choi	Art Unit 1616	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 November 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.☒ A Notice of Appeal was filed on *18 November 2002*. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2.☐ The proposed amendment(s) will not be entered because:

(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ they raise the issue of new matter (see Note below);

(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3.☒ Applicant's reply has overcome the following rejection(s): *112 2nd paragraph rejection over claims 1 and 4*.

4.☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5.☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6.☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7.☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: *1,2,4,8,9,12*.

Claim(s) withdrawn from consideration: _____.

8.☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9.☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10.☐ Other: _____

JOHN PAK
PRIMARY EXAMINER
GROUP 1600

Continuation of 5. does NOT place the application in condition for allowance because:

Composition Claim 12 is dependent on cancelled Claim 11.

With respect to the 102/103 rejection of claims 1,2,4,9 (Examiner notes that claim 10 was cancelled by Amendment (5/31/2002), Applicant argues that WO 96/33181 does not disclose methods of using alkynylene thiazoles to modulate the activity of metabotropic glutamate receptors or treat pain. However, the treatment/prevention of pain and effect on metabotropic glutamate receptors is inherent in the prior art method. See In re May, 197USPQ 601 (CCPA 1978);Ex parte Novitski, 26 USPQ2d 1389 (Bd. Pat. App. & Inter. 1993). Further, with respect to Applicant's argument concerning 2-ethynylthiazoles and claimed alkynylene thiazoles, the formula is not limited to 4-alkynyl thiazole or even alkynylene thiazoles where the alkynylene joins the thiazolyl at a site adjacent to the N and C atom. Similar to a markush group in which only a single member of the markush group need be disclosed for the prior art to meet the limitations of the markush group, the prior art, with respect to the formula, need only disclose one compound which falls within the scope of the formula. Examiner reminds Applicant that in a 102/103 inherency rejection the Graham v. John Deere factors are not applicable, as such, Applicant's arguments relative to obviousness do not appear to overcome the 102/103 inherency rejection.

With respect to the obviousness rejection of claims 4,8,9,12, Applicant does not appear to address the rejection relative to claim 12, a such, Examiner maintains said rejection of claim 12 for the reasons set forth in the prior Office Action. Applicant argues that the prior art does not disclose alkynylene thiazoles such as 4-alkynyl thiazoles, however, as indicated above, the prior art, with respect to the formula, need only disclose a single compound which falls within the scope of said formula. With respect to Applicant's argument that the prior art does not suggest methods of using alkynylene thiazoles to modulate the activity of metabotropic glutamate receptors or treat pain. The prior art does teach methods of treating and preventing varioius diseeases, including angina pectoris. Claim 4 defines the disease condition as being treatable by modulation of the activity of metabotropic glutamate receptors, of which Claim 8 lists the disease conditions. Angina pectoris appears to meet one or more of the disease conditions set forth in claim 8, i.e. acute pain or pain associated with inflammation or tissue injury, and, as such, since the prior art appears to meet the narrower definition of disease condition it also meets the broader definition in claim 4 on which claim 8 is dependent. Prevention of angina pectoris also appears to meet claim 9 in tha prevention of angina pectoris would prevent pain in a subject at risk thereof.